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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,767	10/17/2003	Thomas Andrew Cohen	004875.00002	9829

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/686,767

Applicant(s)

COHEN ET AL

SJ

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/17/2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim body must include a technological nexus (e.g., the computer performing the method).

### ***Claim Rejections - 35 USC § 112***

Claim 22 provides for the use of a computer readable medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

It is noted that the preamble recites a computer readable medium "for operation ... to perform a method ... comprising the steps". The claim language after "for" is interpreted as intended use of the medium only and the claim steps are therefore not positively claimed. In order to promote prosecution, the claim was examined as if the steps were positively recited.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

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definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7, 8, 11, 13-16 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al (6,000,832).

As to claim 7, Franklin et al show registering as a user of a service; providing or authority to seek funds from the service; obtaining a disposable credit card number; and providing the number to a merchant as payment (e.g., col. 2, lines 8-11; col. 7, lines 29-55; col. 9, lines 26-29; col. 11, lines 15-17).

As to claim 8, Franklin et al show all steps (see col. 2, lines 19-27).

As to claim 11, Franklin et al show all elements (see e.g., col. 2, lines 22-38).

As to claim 13 and 14, Franklin et al show authorizing an internet server to issue disposable credit card numbers; receiving in respect of that number a request for funds authority from the server; crediting a merchant or bank owing to the transaction by the

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user using the disposable card and verifying for the service that the particular user's credit card description is valid (e.g., col. 7, lines 29-55; col. 2, lines 8-11, 39; col. 4, lines 35-43).

As to claim 15, Franklin et al disclose performing a real-time authorization for the service when a request is submitted by the service prior to a transaction between the user and the merchant (e.g., col. 9, lines 26-29; col. 11, lines 15-17).

As to claim 16, Franklin et al show performing a number translation via a disposable credit card database, after receiving a request for credit from the merchant and before allocating credit to the merchant (e.g., col. 12, lines 1-48).

As to claim 22, Franklin et al show software enabling a computer processor and data transmitter to perform the steps of transmitting identification information from a user and receiving from the service a disposable credit card number that is transaction specific and having the same format as a credit card number acceptable to a merchant linked to said service (e.g., col. 7, lines 29-55, col. 2, lines 8-11, 39; col. 4, lines 10-22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (6,000,832) in view of Cohen (6,422,462).

As to claims 1 and 2, Franklin et al show receiving information from a user and authorizing the user based on that information; establishing an account for the user; and issuing the user with a disposable credit card number which has the same format as a credit card which is accepted by a merchant that the user will pay; wherein the issuance of the disposable number is done with the authority of a central bank which belongs to a credit card scheme (e.g., col. 7, lines 29-55, col. 2, lines 8-11, 39). Franklin et al do not show disabling the account after the number has been issued; and re-enabling the account only after a reply to a transaction confirmation has been received. Cohen shows this step (see e.g., col. 12, lines 40-45). It would have been obvious to one of ordinary skill in the art to modify the method of Franklin et al as taught by Cohen in order to prevent fraudulent charges being made via the number.

As to claim 6, Franklin et al show prior to the completion of a user's purchase from the merchant, receiving funds; the receiving accomplished by check or by debiting a user's credit card as though the user were purchasing a stored value card (e.g., col. 11, lines 15-23; col. 12, lines 44-47).

As to claims 19-21, Franklin et al show issuing the user with the disposable credit card is accomplished over the Internet, between a server operated by the service and a client operated by the user, where the client is not a browser and communicates over the internet only with the server (col. 4, lines 22-43).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al in view of Cohen as applied to claim 1 above, and further in view of "An Efficient Fair Payment system" (hereinafter EFPS).

Franklin et al in view of Cohen show all elements except seeking funds from a central bank at the request of the user and creating the user's account accordingly; and not supplying the central bank with an identity of the user in respect of a request for credit by the central bank. EFPS shows seeking funds from a central bank at the request of the user and creating the user's account accordingly; and not supplying the central bank with the identity of the user in respect of a request for credit by the bank (e.g. pg. 90-91). It would have been obvious to one of ordinary skill in the art to further modify the method of Franklin et al as taught by EFPS in order to provide security and privacy to the user.

As to claim 4, Franklin et al in view of Cohen show all elements except obtaining a deposit in an account, from a user, from which deposit is used against the disposable credit card number. EFPS shows this step (see e.g., p.91). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to further modify the method Franklin et al as taught by EFPS in order to assist in keeping the user's identity anonymous.

Claims 9, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al in view of Walker et al (5,945,653).

Franklin et al show all elements except that the service provider appear as the creditor on any related financial statement. Walker et al sho the service appearing as the creditor on the financial statements (e.g., col. 21, lines 20-26; fig. 9 ref. 902). It would have been obvious to one of ordinary skill in the art to modify the method of Franklin et al as taught by Walker et al in order to display transaction detail to the user which "indicate the activities carried out or executed by the card issuer" (Walker col. 21, lines 20-26).

As to claims 17 and 18, Franklin et al show all elements except providing the name of the merchant on a statement sent to the user. Walker et al show this element. It would have been obvious to one of ordinary skill in the art to modify the method of Franklin et al by providing the name of the merchant on the statement in order to present conventional and essential transaction details to the user.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al in view of "ActiveNames Free Internet Service" (Activenames).

Franklin et al show all elements except replying, by email to a confirmation of a transaction sent by the service. Activenames shows replying by email to a confirmation of a transaction sent by the service (e.g., pg. 2, lines 6-15). It would have been obvious to one of ordinary skill in the art to modify the method of Franklin et al as taught by Activenames in order to provide verification and to allow the user to transmit messages remotely.



Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (6,000,832).

As to claim 10, Franklin et al show all elements except nomination of an irreversible credit limit by the user. However, to nominate such a limit is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Franklin et al by having the user propose a credit limit in order to enable the financial product to more closely suit his needs.

As to claim 23, Franklin et al show establishing an Internet connection between a special purpose client and a central server (e.g., Fig. 2) wherein the card issuer is remote from the server (the "bank" as considered in Fig. 2 can be a third party under contract with the bank as in col. 4, lines 3-9). Franklin et al inherently show forward the request from the third party server to the central issuing bank since it shows the user submitting the request to a third party, but requiring approval from the central issuing bank (e.g., col. 7, lines 39-54). Franklin et al further inherently show obtaining funds authority from the central issuing bank and supplying the disposable card after the authority has been received since it is necessary for the third party to receive such authority before granting the card. Franklin et al do not show using a secure internet connection between the user and the third party server, or using a secure closed network between the third party server and the issuing central bank. However, the use of such connections are notoriously old and well known in the art. It would have been

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obvious to one of ordinary skill in the art to use such secure connections in order to prevent data theft.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

**STEVE B. MCALLISTER  
PRIMARY EXAMINER**